

Remarks:

R1 Applicant notes that the Examiner has only undertaken a cursory review of the Applicant's submission of Sept. 28, 2007. In the interest of advancing prosecution, and without prejudice, Applicant submits a Request for Continued Examination herewith.

R2 Applicant notes that previous amendments to the specification and claims have not been entered. In view of the Festo v. Shoketsu decision 535 U.S. 722, 62 USPQ2d 1705 (2002), Applicant proceeds herein by way of reference to previous arguments presented in the Applicant's submission of Sept. 28, 2007 in order to minimize file wrapper estoppel.

Therefore, without prejudice, Applicant respectfully retains all previous arguments on file and particularly arguments in Applicant's submission of Sept. 28, 2007. The present submission does not intend to replace, but rather to augment, Applicant's submission of Sept. 28, 2007. No argument presented herein is intended to replace any previously presented argument. Arguments presented herein are intended to add to previously submitted arguments. Any absent mention of an outstanding issue herein is not to be construed as an admission of any of Examiner's prior assertions.

Reconsideration of Applicant's previous submission of Sept. 28, 2007 is respectfully requested and appreciated.

R3 Claims 1 to 10a, 10b, and 11 are pending in the application. Claims 1 to 10a, 10b, and 11 stand rejected.

Arguments:

A1 Applicant notes that the Examiner has not entered previously submitted amendments to, as, in the Examiner's view, the amendment to the Specification constitutes a new matter.

Applicant respectfully submits that the amendments to the Specification were presented based on, and attempt to adopt, Examiner's suggestions. Remark K of Applicant's Sept. 28, 2007 submission states that amendments to consistatory paragraphs [0007], [0008], and [0009] mirror amendments to the independent claims 1, 10a and 10b. Amendments to paragraph [0007] concern only amendments to independent claim 1 currently on file. Amendments to paragraph [0008] concern only proposed amendments to independent claim 10a. Remark D and Argument E of Applicant's Sept. 28, 2007 submission propose amending independent claim 10a, in compliance with Examiner's invitation, along non-objectionable wording of claim 7 currently on file. Amendments to paragraph [0009] concern only amendments to independent claim 10b, amendments which were undertaken to correct clerical errors, comply with the Examiner's invitation to correct, and to put the claims in better condition for allowance as stated in Remarks G and H of Applicant's submission of Sept. 28, 2007.

Applicant notes that the Examiner did not object to the proposed claim amendments.

MPEP §714.13 II at first paragraph reads "... The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration ... if the proposed amendment raises the issue of new matter, the examiner should

identify the subject matter that would constitute new matter. If the proposed amendment presents new issues requiring further consideration and/or search, the examiner should provide an explanation as to the reasons why the proposed amendment raises new issues that would require further consideration and/or search. The reasons for nonentry should be concisely expressed.”

Applicant respectfully notes that the requisite reasons for non-entry of the amendments is absent from the Advisory Action.

Therefore Applicant respectfully requests entry of the amendments.

A2 Applicant notes that the Examiner has stated that the proposed claim amendments require further consideration, while at the same time the Examiner positively and with certitude states that the “claim limitations are not in condition for allowance” following the cursory review.

Applicant respectfully submits, based on the Examiner's own submission, that the Examiner failed to provide support for the stated conclusion with respect to the condition of the claims.

A3 In the Applicant's Sept. 28, 2007 submission Arguments A to D concern Examiner's previous double patenting objections.

Applicant thanks the Examiner for clarifying that the provisional rejection is not applicable.

Applicant respectfully suggests that it would be improper for the USPTO to requisition a terminal disclosure in order to rectify patent term adjustment differences which stem from delays incurred at the USPTO.

In view of the facts:

- that a terminal disclaimer would be irrevocable;
- that the Applicant's Sept. 28, 2007 submission has only had a cursory review; and
- that the Examiner did not provide a reply to Applicant's Argument C presented in the Sept. 28, 2007 submission,

without prejudice and with full intent to advance prosecution, Applicant respectfully proposes reconsidering Examiner's terminal disclaimer requisition after Examiner's reply to Applicant's Argument C presented in the Sept. 28, 2007 submission will be considered.

A4 Claims 1, 3 to 10a and 10b stand rejected under 35 U.S.C. §102(e).

The requirements of 35 U.S.C. §102(e) are strict. In *W. L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983) the Federal Circuit stated that

"[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." It is not enough for a prior art reference to disclose claimed elements in isolation. Rather, as stated by the Federal Circuit in *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984),

"[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.", and further indicated in the same decision that "[i]n deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in the light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference. The Examination Guidelines of the USPTO adopt the above. Before articulating a rejection, the Examiner must first obtain a through understanding of the invention disclosed and claimed in the

application by reading the specification to understand what has been invented. See MPEP §904 (8th Ed., Rev. 5, Aug. 2006 unchanged by amendments of Oct. 2007). In articulating the rejection, the onus rests with the Examiner to particularly point out how the Examiner construed the prior art to arrive at the articulated rejection.

Arguments K to Q point out failures to establish a prima facie case of anticipation in view of the above. Applicant respectfully submits that the Examiner's cursory review fails to take into consideration the above. In particular, giving claim language the broadest interpretation is not done in a vacuum but rather in the context of the specification. In *Scripps Clinic & Research Found. V. Genentech Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991), the Federal Circuit stated that the anticipation determination must be viewed from one of ordinary skill in the art: "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention."

Applicant respectfully proposes, with reference to Argument O submitted Sept. 28, 2007 amending all references to a "carrier" to read --carrier telecommunications company--.

A5 Applicant notes that all pending claims 2 and 11 have been rejected under 35 U.S.C. §103(a) as stated at point 15 of the outstanding final Office Action. The outstanding Final Office Action has been issued following the United States Supreme Court's decision in *KSR Int'l Co. v. Teleflex Inc.*, No. 04-1350 (April 30, 2007). In light of the KSR decision, Applicant wishes to address various issues pertaining to a proper analysis under section 103.

Applicant notes the statement of the Graham factual inquiries presented by the Examiner at point 14 of the outstanding final Office Action. Applicant further respectfully submits that,

even after KSR, the following legal principles are still valid, having been endorsed by the

Supreme Court or having been unaffected by the KSR decision:

- (1) the USPTO still has the burden of proof on the issue of obviousness;
- (2) the USPTO must base its decision upon objective evidence, and it must support its decision with articulated reasoning (slip op. at 14);
- (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of obviousness (slip op. at 14-15);
- (4) hindsight has no place in an obviousness analysis (slip op. at 17); and
- (5) Applicant is entitled to a careful, thorough, professional examination of the claims (slip op. at 7, 23, in which the Supreme Court remarked that a poor examination reflected poorly upon the USPTO).

The Examiner, by citing references and asserting a reason for combining elements from the references, has elected to base the rejection upon a teaching, suggestion or motivation to select and combine features from the cited references. Applicant wishes to point out that the Supreme Court's KSR decision did not reject use of a "teaching, suggestion or motivation" analysis as part of an obviousness analysis, characterizing the analysis as "a helpful insight." KSR slip op. at 14-15.

When the Examiner chooses to base a rejection upon a teaching, suggestion or motivation analysis, the Examiner must satisfy the requirements of such an analysis. In particular, the Examiner must demonstrate with objective evidence of record and articulate a reasoned argument that there was a teaching, suggestion or motivation to select and combine features from the cited references. E.g., *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Moreover,

objective evidence found in the prior art must suggest the desirability of the combination, not merely the feasibility. In re Fulton, 73 USPQ2d 1141, 1145 (Fed. Cir. 2004).

In order to establish a prima facie case of obviousness, irrespective of the rationale proposed by the Examiner in rejecting a claim, the Examiner must produce objective evidence of record from the prior art showing a reasonable expectation of success from such combination. (see MPEP2143.02) In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986), and Ex parte Blanc, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

A6 Arguments G to I in Applicant's Sept. 28, 2007 submission point out deficiencies of the Examiner's final rejection including: failure to produce objective evidence of record of the desirability of the combination, failure to show based on objective evidence of record a reasonable expectation of success in combining the references cited, and the inappropriate use of subjective belief.

Respectfully, Examiner's comments in the Advisory Action are not supported by objective evidence of record and prefacing statements in an articulated rejection with "One would expect ..." qualifies the statement as a subjective one.

MPEP §2144.03 Summary reads "Any rejection based on assertions that a fact is well-known or is common knowledge in the art without documentary evidence to support the examiner's conclusion should be judiciously applied. Furthermore, as noted by the court in Ahlert, any facts so noticed should be of notorious character and serve only to "fill in the gaps" in an insubstantial manner which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon

which a rejection was based. See Zurko, 258 F.3d at 1386, 59 USPQ2d at 1697; Ahlert, 424 F.2d at 1092, 165 USPQ 421.”

Argument G of the Applicant's Sept. 28, 2007 submission demonstrates the undesirability of the combination of the prior art references cited particularly as one of the references cited teaches away. Applicant notes that the Examiner did not rebut the Applicant's finding that one of the cited references teaches away. Merely stating that something “provides a predictable result” without more, is insufficient to comply with the required showing based on objective evidence of record a reasonable expectation of success in combining the references cited. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1988)

Reconsideration and allowance are respectfully requested.

Respectfully submitted,

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